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EXAMINER

SCHLACK, SCOTT A

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/072,180	Applicant(s) HEIMENDINGER ET AL.	
	Examiner Scott A. Schlack	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/18/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim **23** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically claim 23 discloses generating an address corresponding to a portion of the image data. The examiner notes that there is insufficient antecedent basis for this limitation, as nowhere in the specification is it disclosed wherein an address is generated corresponding to said portion of the image data. Revisions are required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1-6, 8-15, 17, 19** and **24-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Wong et al. (US 5,550,649).
5. With respect to claim **1**, Wong et al. (Wong) discloses an annotation processing apparatus comprising: an image data interface (Facsimile Instrument 11 with DRAM 65 of Fig 2 capable of image data storage and communication, col 2, lines 61-63 and col 3, lines 61-62); an annotation interface (Facsimile Instrument 11 with ARAM 67 of Fig 2

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capable of voice data storage and communication, col 2, lines 61-63 and col 3, lines 64-65); and a processor (Processor 51 in Instrument 11 of Fig 2), coupled to said image data interface and said annotation interface; wherein said processor detects a transmission of image data presented at said image data interface and controls said annotation interface to prompt a user to supply an annotation (col 6, lines 22-40 and 181, 183,185 of Fig 4).

The examiner notes that both the image data interface and the annotation interface are necessarily inherent to the functionality of Wong's facsimile device (Instrument 11 of Figs 1-2 and Fig 4).

6. With respect to claim 2, Wong discloses the apparatus according to claim 1 further comprising a data storage coupled to said processor; and wherein said processor controls said data storage to store said annotation received via said annotation interface (Processor 51 coupled with ARAM 67 of Fig 2 capable of voice data storage and communication, col 2, lines 61-63 and col 3, lines 64-65).

7. With respect to claim 3, Wong discloses the apparatus according to claim 2 further comprising a communications interface (Input/Output Device 35 and 39 of Figs 1-2) coupled to said processor (Processor 51 of Fig 2); and wherein said processor retrieves said annotation from said storage and transmits said annotation to a recipient via said communications interface (183, 193 and 201 of Fig 4, col 6, lines 22-67 and col 7, lines 1-18).

8. With respect to claim 4, Wong discloses the apparatus according to claim 3 wherein said processor (Processor 51 of Fig 2) controls said image data interface to

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emulate one of a network, a network device and a computer (Facsimile Instrument 11 with DRAM 65 of Fig 2 capable of image data storage and communication, col 2, lines 61-63 and col 3, lines 61-62).

The examiner interprets the processor controlling the image data interface to emulate that of a network device and likewise a computer (Facsimile Instrument 11 with DRAM 65 of Fig 2 capable of image data storage and communication, col 2, lines 61-63 and col 3, lines 61-62).

9. With respect to claim 5, Wong discloses the apparatus according to claim 3 wherein said processor (Processor 51 of Fig 2) controls said data storage to store an image data received via said image data interface (Facsimile Instrument 11 with DRAM 65 of Fig 2 capable of image data storage and communication, col 2, lines 61-63 and col 3, lines 61-62); and wherein said processor retrieves said image data from said storage and transmits said image data to said recipient (183, 193 and 201 of Fig 4, col 6, lines 22-67 and col 7, lines 1-18) via said communications interface (Input/Output Device 35 and 39 of Figs 1-2).

10. With respect to claim 6, Wong discloses the apparatus according to claim 3 wherein said processor creates a modified image data by modifying an image data received via said image data interface (257 of Fig 6A and col 9, lines 15-19); and wherein said processor causes said modified image data to be transmitted to said recipient via said communications interface (259 of Fig 6A and col 9, lines 19-21).

The examiner views the conversion of the image data to Bitmap to be equivalent to modifying the image data (257 of Fig 6A and col 9, lines 15-19).

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11. With respect to claim **8**, Wong discloses the apparatus according to claim 6 wherein said modified image data and said image data are formatted according to different protocols (col 7, lines 15-18).

The examiner notes that the annotated voice signal is capable of being converted/reconstructed to conform to a different transmission protocol (col 7, lines 15-18).

12. With respect to claim **9**, Wong discloses the apparatus according to claim 1 further comprising a user interface coupled to said processor (Processor 51 of Fig 2); and wherein said processor receives via said user interface a user command to control an operation of the apparatus (Control Switches 41 and LCD screen 45 on Front Panel of Facsimile Instrument 11 of Fig 1).

13. With respect to claim **10**, Wong discloses the apparatus according to claim 1 wherein said annotation interface comprises a telephone handset (Telephone 15 of Fig 1).

The examiner interprets the connected Telephone, with handset (15 of Fig 1), to be an extension of the facsimile Instrument (11 of Fig 1 and col 2, lines 19-24), and therefore views the microphone (29 of Fig 1) on the instrument to be analogous to that of the microphone on the attached telephone.

14. With respect to claim **11**, Wong discloses a method of annotating an image data comprising the steps of: receiving a transmission of said image data to a recipient; receiving from an annotation source an annotation corresponding to the image data;

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and transmitting said annotation to the recipient (193 of Fig 4, col 6, lines 22-67 and col 7, lines 1-18).

15. With respect to claim **12**, Wong discloses the method according to claim 11 further comprising the step of transmitting said image data to the recipient for the image data (201 of Fig 4, col 6, lines 22-67 and col 7, lines 1-18).

16. With respect to claim **13**, Wong discloses the method according to claim 11 further comprising the step of retrieving from storage a transmission preference corresponding to the recipient (251, 253 and 257 of Fig 6A); and wherein said step of transmitting comprises the step of transmitting said annotation to the recipient in accordance with said transmission preference (col 9, lines 3-24).

The examiner notes that the fax data is retrieved from storage (DRAM 65 of Fig 2) with a transmission preference relating to inclusion of voice annotation (fax message log) and fax conversion to bitmap, when transmitting data to the CRT Controller and Television (17 of Fig 1 and col 9, lines 3-24).

17. With respect to claim **14**, Wong discloses the method according to claim 13 wherein said transmission of said image data to the recipient is by a first communications protocol; wherein the transmission of said annotation to the recipient is by a second communications protocol; and wherein said first communications protocol is different from said second communications protocol (col 7, lines 15-18).

The examiner notes that the annotated voice signal is capable of being converted/reconstructed to conform to a different transmission protocol (col 7, lines 15-18).

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18. With respect to claim **15**, Wong discloses the method according to claim 13 wherein said transmission of said image data to the recipient is by a first communications system (Fax/modem circuit 87 and Fax 85 Line of Fig 3); wherein the transmission of said annotation to the recipient is by a second communications system (Voice circuit 91 and Voice Line 93 of Fig 3); and wherein said first communications system is different from said second communications system (col 4, lines 18-38 and col 5, lines 17-41).

The examiner views the Fax (87) and Voice (93) Circuits connected to their respective communications lines (85 and 93), to be equivalent to a first and second communications system.

19. With respect to claim **17**, Wong discloses the method according to claim 11 wherein said annotation source is a user-controlled audio input device (Telephone 15 or Microphone 27 of Fig 1).

20. With respect to claim **19**, Wong discloses the method according to claim 11 further comprising the step of transmitting an indication of annotation to the recipient (243 and 245 of Fig 5B and col 8, lines 41-54).

The examiner notes the voice flag acts as an indication of annotation to the recipient (col 8, lines 41-54).

21. With respect to claim **24**, Wong discloses an image data and annotation communication system comprising: an image and annotation processing system (Facsimile Instrument 11 of Fig 1); and a communications network coupled to said image and annotation processing system (col 2, lines 61-67 and col 3, line 1).

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22. With respect to claim **25**, Wong discloses a system according to claim 24 further comprising a source of image data coupled to said image and annotation processing system (col 6, lines 22-67 and col 7, lines 1-18).

The examiner views the facsimile Instrument (11 of Fig 1) to act as both a source of image data and an image and annotation processing system.

23. With respect to claim **26**, Wong discloses a system according to claim 24 further comprising an annotation source coupled to said image and annotation processing system (col 6, lines 22-67 and col 7, lines 1-18).

The examiner views the facsimile Instrument (11 of Fig 1) to act as both a source of annotation data and an image and annotation processing system.

24. With respect to claim **27**, Wong discloses a system according to claim 24 further comprising an annotation playback system coupled to said communications network (261 of Fig 6A and TV 17 of Fig 1).

The examiner views the TV to act as the annotation playback system coupled to said communications network, but also notes it could just as well be the computer (19 of Fig 1)

25. With respect to claim **28**, Wong discloses a system according to claim 24 wherein said communications network comprising communications systems utilizing at least one of a satellite communications system, a local area network (col 2, lines 61-67 and col 3, line 1), a wide area network (col 2, lines 61-67 and col 3, line 1), the Internet, a public telephone system (16 of Fig 1), an optical communications system, and a wireless communications system.

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The examiner views the computer network disclosed in Wong to be equivalent to either a LAN or WAN (col 2, lines 61-67 and col 3, line 1). The examiner also notes the PSTN connection (16 of Fig 1).

26. With respect to claim **29**, Wong discloses a system according to claim 24 wherein said image and annotation processing system comprises: an annotation transmission device (Facsimile Instrument 11 of Fig 1) operable to transmit an annotation through said communications network (col 2, lines 61-67 and col 3, line 1) by a first protocol different than a second protocol by which an image data is transmitted through said communications network (col 7, lines 15-18).

27. With respect to claim **30**, Wong discloses a system according to claim 24 wherein said image and annotation playback system comprises: a facsimile machine having a handset (Facsimile Instrument 11 with connected telephone handset 15 of Fig 1); and a voice messaging system (col 1, lines 35-40).

The examiner interprets the annotated voice messaging system to qualify as a voice messaging system.

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claim **7** and **20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (US 5,550,649) in view of Klein (US 5,479,411).

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30. With respect to claim **7**, Wong discloses the apparatus according to claim 6. Wong does not disclose wherein the modified image data includes an indication of separate annotation.

Klein does disclose facsimile data containing an indication of annotated voice data through an annotated (voice) file pointer within the header appended to the facsimile data (col 3, lines 52-63).

Wong and Klein are analogous art, because they are from the same field of endeavor, namely Facsimile Communications.

At the time of the invention, it would have been obvious for one skilled in the art to combine Wong's apparatus according to claim 6, with Klein's facsimile data containing an indication of annotated voice data through an annotated (voice) file pointer within the header appended to the facsimile data, such that the modified image data of Wong contained an indication of the separate voice annotation.

The suggestion or motivation for doing such would have been to append the separate voice annotation indication or voice message flag (as disclosed in Wong), to the modified image file.

31. With respect to claim **20** the examiner notes identical features to claim 7.

Therefore, the explanation given above for claim 7 is also valid for claim 20.

32. Claim **16** and **21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (US 5,550,649).

33. With respect to claim **16**, Wong discloses the method according to claim 11 further comprising the steps of: retrieving from storage a transmission preference

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corresponding to the recipient (251, 253 and 257 of Fig 6A); and receiving from the user a transmission instruction; and wherein said step of transmitting comprises the step of transmitting said annotation to the recipient in accordance with said transmission instruction (col 9, lines 3-45).

The examiner notes that the fax data is retrieved from storage (DRAM 65 of Fig 2) with a transmission preference relating to inclusion of voice annotation (fax message log) and fax conversion to bitmap, when transmitting data to the CRT Controller and Television (17 of Fig 1 and col 9, lines 3-24). The examiner also notes that the user can provide transmission instruction via the facsimile instrument panel switches (41 of Fig 1) or via a remote (31 of Fig 1) to effect transmission data (col 9, lines 25-45).

Wong does not disclose displaying said transmission preference to a user, however, Wong does disclose the Facsimile Instrument (11 of Fig 1) comprising a Liquid Crystal Display (LCD 45 of Fig 1) for displaying various modes and messages to the user regarding transmission (col 3, lines 29-41).

It would have therefore been obvious for one skilled in the art at the time of the invention, to combine Wong's stored transmission preferences with his LCD (45 of Fig 1), such that the transmission preference was displayed on the LCD to the user.

The suggestion or motivation for doing so would have been to explicitly state that the transmission preference was displayed to the user.

34. With respect to claim **21**, Wong discloses a method of annotating an image data comprising the steps of: receiving a transmission of said image data to a recipient;

receiving from an annotations source an annotation corresponding to the image data (col 6, lines 22-67 and col 7, lines 1-18).

Wong does not disclose displaying said annotation to a user nor receiving from the user a second annotation and transmitting said second annotation to the recipient from the image data. However, the examiner notes that Wong discloses presenting the annotation to the user via output means (col 9, lines 21-24). The examiner views this to be analogous to displaying the annotation to the user and further notes that claiming different embodiments wherein the annotation is sound or video or text, etc. constitutes different species of the applicant's invention (warranting restriction).

Further, the examiner notes that repeating processes disclosed in prior art does not differentiate the applicant's invention from that of the prior art, as the same functionality is achieved (only repeated). Therefore, claiming receiving a first or second or even third annotation, still points to the same functionality, which is not patentably distinct from Wong (Figs 6A-B).

Therefore these variations would have been obvious to those skilled in the art at the time of the invention and are not patentable distinct from Wong.

35. Claim **18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (US 5,550,649) in view Prior Art.

36. With respect to claim **18**, Wong discloses the method according to claim 11.

Wong does not specifically disclose wherein the annotation source is a user-controlled video input device.

The examiner takes official notice that user-controlled video input devices were prevalent at the time of the invention.

It would have been obvious for one skilled in the art to combine Wong's annotation source with that of a user-controlled video input device.

The suggestion or motivation for doing so would have been to explicitly state that the user input device was a user-controlled video input device.

37. Claim **22-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (US 5,550,649) in view of Hansen et al. (US 6,407,820).

38. With respect to claim **22**, Wong discloses a method of annotating an image data comprising the steps of: receiving a transmission of said image data to a recipient; displaying said image data to a user (Fig 5A-B and 6A-B)

Wong does not disclose receiving a selection of a portion of said image data from the user; receiving from an annotation source an annotation corresponding to said portion.

Hansen discloses selection of a portion of an image data from a user and annotation of said selected portion of said image data (col 10, lines 52-64).

Wong and Hansen are analogous art, because they are from the same field of endeavor, namely Image Data Annotation.

At the time of the invention, it would have been obvious for one skilled in the art to combine Wong's method of annotating an image data comprising the steps of: receiving a transmission of said image data to a recipient; displaying said image data to a user, with Hansen's selection of a portion of an image data from a user and

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annotation of said selected portion of said image data, such the receiver is sent a selection of a portion of said image data from the user along with a corresponding annotation to said selected portion.

The suggestion or motivation for doing so would have been to allow for annotations to be sent pertaining to different portions of the image data.

39. With respect to claim **23**, Wong in view of Hansen disclose the method according to claim 22 further comprising the steps of generating an address corresponding to said portion (Wong: col 9, lines 5-14); and transmitting said address to the recipient (Wong: Fig 4).

The examiner notes that in the combination of Wong in view of Hansen, wherein portions of the transmitted image data are annotated, the feature of the annotations being associated with there respective portions of the image data would require the annotations to be addressed in some way corresponding to said image data. The examiner views this to be necessarily inherent to the combination of Wong in view of Hansen. Further, Wong discloses the annotation data being addressed in storage as to correspond to the image data (Wong: col 9, lines 5-14).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner notes that Brandman et al. (US 5,483,580), Misholi et al. (US 5,317,628), Brunson (US 5,647,002), Irribarren et al. (US 5,530,740) and Owens et al. (US 6,633,630) all disclose appending annotations to image data and communications thereof.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Schlack whose telephone number is (571)272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Note to the applicant: Art Unit 2624 has been redesignated as Art Unit 2625 due to organizational restructuring with the USPTO.



Scott A. Schlack



KIMBERLY WILLIAMS
SUPERVISORY EXAMINER